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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Eiji Isono

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7590

06/19/2006

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WASHINGTON, DC 20004

EXAMINER

SPAHN, GAY

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/519,463	ISONO, EIJI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gay Ann Spahn	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>28 March 2005</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 28 March 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

(1) "plate is screwed to an opposing assembly member screw fixing portion at time of assembling" as specifically recited in claim 1,

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because:

(1) Fig. 1, section line "A-A" should be changed to either --2-2-- or --II-II-- since 37 CFR 1.84(h)(3) requires section lines to be "designated by Arabic or Roman numerals corresponding to the view number of the sectional view"; and

(2) Fig. 5, section line "B-B" should be changed to either --6-6-- or --VI-VI-- since 37 CFR 1.84(h)(3) requires section lines to be "designated by Arabic or Roman numerals corresponding to the view number of the sectional view."

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Figures 5-7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

- (1) page 10, line 6, change "A-A" to either --2-2-- or --II-II--;
- (2) page 10, line 15, change "B-B" to either --6-6-- or --VI-VI--; and
- (3) page 10, line 24, change "A-A" to either --2-2-- or --II-II--.

Appropriate correction is required.

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification appears to be a direct translation from a foreign language and is replete with grammatical errors which render the specification to be not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

- (1) the last full sentence on page 5 (i.e., (1) what does "crossed in the plane shape thereof" mean?;
- (2) "there are a case" should be --there is a case--;
- (3) is "it" the inflection portion?;
- and (4) what is "a case that the it" trying to say?).

The examiner notes that she has listed but one example of the many grammatical problems in the specification since the specification appears to be a direct translation from a foreign language and the Applicant should go through the entire specification and fix all of the grammatical problems.

A substitute specification (excluding the claims) without markings is required pursuant to 37 CFR 1.125(a) because the present marked-up specification would render it difficult to arrange the pages for printing (i.e., the interlineations or cancellations made

in the specification could lead to confusion and mistake during the issue and printing processes). Therefore, a clean copy of the specification (i.e., substitute specification) is being required per 37 CFR § 1.125(c).

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. **An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter (per 37 CFR 1.125(b)(1)) must also be supplied.**

Numbering the paragraphs of the specification of record is not considered a change that must be shown.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, lines 2-3, the recitation of "wherein a packing is firmly fixed to one surface of a plate with predetermined plane arrangement" is vague, indefinite, and confusing because it is not understood what is meant by "a predetermined plane arrangement" and it is not known whether the packing or the plate has the predetermined plane arrangement.

Claim 1, lines 7-11, the recitation of "a packing extension portion for partly enlarging an adhesive bonding area of said packing to said plate is provided in a position close to said screw fixing portion, an inflection portion, or a position close thereto in a plane shape of said packing" is vague, indefinite, and confusing because:

(1) it is not understood how the packing extension portion (9) partly enlarges an adhesive bonding area of said packing (3) (i.e., either it does enlarge the adhesive bonding area or it does not);

(2) it is not understood where the packing extension portion is provided (i.e., is it in any one of a position close to said screw fixing portion, a position close to an inflection portion, a position close to the screw fixing portion, or a position close to an inflection portion);

(3) it is not understood what constitutes "an inflection portion"; and

(4) it is not understood what is meant by "in a plane shape of said packing".



Claim 2, lines 3-5, the recitation of "said packing is bent to one side in a width direction by being compressed in a lip portion by said opposing assembly member" is vague, indefinite, and confusing and should be changed to something similar to --a lip portion of said packing is bent to one side in a width direction when said lip portion of said packing is compressed by said opposing assembly member--.

Claim 2, lines 5-8, and claim 3, lines 3-6 the recitation of "a packing extension portion for partly enlarging an adhesive bonding area of said packing to said plate is provided in an inflection portion or a position close thereto in a plane shape of said packing" is vague, indefinite, and confusing because:

(1) it is not understood how the packing extension portion (9) partly enlarges an adhesive bonding area of said packing (3) (i.e., either it does enlarge the adhesive bonding area or it does not);

(2) it is not understood where the packing extension portion is provided because it is not understood what constitutes "an inflection portion"; and

(3) it is not understood what is meant by "in a plane shape of said packing".

Claim 4, lines 2-6, the recitation of "said gasket constituted by an integrally formed gasket in which the packing is integrally formed in the plate, and a pouring hole of a gasket forming material of a metal mold at a time integrally forming the gasket is arranged on the packing extension portion" is vague, indefinite, and confusing because:

(1) it is not understood how the packing could be integrally formed "in the plate" (i.e., perhaps it should be "on the plate");

(2) it is not understood what the packing is integrally formed with (i.e., the packing and the packing extension portion are integrally formed?);

(3) a pouring hole must be of the metal mold, not of a gasket forming material;  
and

(4) Applicant appears to be trying to claim the protrusion (13) shown in Fig. 2, but using method step language to do so which is not permissible.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIYAKE et al. (Japanese Patent Application Publication No. JP 2003-049949) in view of any one of SHIKANO (U.S. Patent No. 5,568,341), ISHII et al. (Japanese Patent Application Publication No. JP 09-282860), or NAKADA (Japanese Patent Application Publication No. JP 05-326731).**

**As to claim 1** (and as best understood despite the 35 USC 112, second paragraph, indefiniteness discussed above), MIYAKE et al. disclose a gasket (1), wherein a packing (part of base 1a under lip portion 2 and lip portion 2) is firmly fixed (see JPO's computer translation, section entitled "Effects of the Invention", paragraph no. [0039], wherein it states that base 1a is pasted to the top covering base material 4)

to one surface (top surface of 4) of a plate (4) with a predetermined plane arrangement, said plate (4) is brought within a distance S to an opposing assembly member (5) at time of assembling (see Fig. 2), said packing (part of base 1a under lip portion 2 and lip portion 2) is bent to one side in a width direction by being compressed in a lip portion (2) by said opposing assembly member (5), and a packing extension portion (right side of base 1a not under lip portion 2) for partly enlarging an adhesive bonding area of said packing (part of base 1a under lip portion 2 and lip portion 2) to said plate (4).

MIYAKE et al. also disclose that his gasket prevents invasion of electronic equipment such as a top covering of a hard disk drive unit (see computer translation, section entitled "Field of the Invention", paragraph no. [0001]).

However, MIYAKE et al. fail to explicitly disclose that said plate is screwed to an opposing assembly member screw fixing portion at time of assembling, and that said packing extension portion is provided in a position close to said screw fixing portion or a position at or close to an inflection portion in a plane shape of said packing.

Any one of SHIKANO, ISHII et al., or NAKADA disclose electronic equipment in the form of a hard disk drive in which a plate is screwed to an opposing assembly member screw fixing portion at time of assembling. Thus, a gasket comprised of a packing and a packing extension portion would be provided in a position close to said screw fixing portion, an inflection portion, or a position close thereto in a plane shape of said packing because all of SHIKANO, ISHII et al., and NAKADA indicate that projecting portions are provided near the inflections and screw fixing portions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of MIYAKE et al. by providing it between the screwed together hard disk drive plates having inflection and screw fixing portions of any one of SHIKANO, ISHII et al., or NAKADA in order to have a gasket with a larger adhesion surface so as to better resist a bending moment to the gasket from being peeled away from the plate.

**As to claim 2** (and as best understood despite the 35 USC 112, second paragraph, indefiniteness discussed above), MIYAKE et al. disclose a gasket (1), wherein a packing (part of base 1a under lip portion 2 and lip portion 2) is firmly fixed (see JPO's computer translation, section entitled "Effects of the Invention", paragraph no. [0039], wherein it states that base 1a is pasted to the top covering base material 4) to one surface (top surface of 4) of a plate (4) with a predetermined plane arrangement, said packing (part of base 1a under lip portion 2 and lip portion 2) is bent to one side in a width direction by being compressed in a lip portion (2) by said opposing assembly member (5), and a packing extension portion (right side of base 1a not under lip portion 2) for partly enlarging an adhesive bonding area of said packing (part of base 1a under lip portion 2 and lip portion 2) to said plate (4).

MIYAKE et al. also disclose that his gasket prevents invasion of electronic equipment such as a top covering of a hard disk drive unit (see JPO's computer translation, section entitled "Field of the Invention", paragraph no. [0001]).

However, MIYAKE et al. fail to explicitly disclose that said packing extension portion is provided in an inflection portion or a position close thereto in a plane shape of said packing.

Any one of SHIKANO, ISHII et al., or NAKADA disclose electronic equipment in the form of a hard disk drive in which a plate is screwed to an opposing assembly member screw fixing portion at time of assembling. Thus, a gasket comprised of a packing and a packing extension portion would be provided in an inflection portion or a position close thereto in a plane shape of said packing because all of SHIKANO, ISHII et al., and NAKADA indicate that projecting portions are provided near the inflections and screw fixing portions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of MIYAKE et al. by providing it between the screwed together hard disk drive plates having inflection and screw fixing portions of any one of SHIKANO, ISHII et al., or NAKADA in order to have a gasket with a larger adhesion surface so as to better resist a bending moment to the gasket from being peeled away from the plate.

**As to claim 3** (and as best understood despite the 35 USC 112, second paragraph, indefiniteness discussed above), MIYAKE et al. disclose a gasket (1), wherein a packing (part of base 1a under lip portion 2 and lip portion 2) is firmly fixed (see JPO's computer translation, section entitled "Effects of the Invention", paragraph no. [0039], wherein it states that base 1a is pasted to the top covering base material 4) to one surface (top surface of 4) of a plate (4) with a predetermined plane arrangement,

and a packing extension portion (right side of base 1a not under lip portion 2) for partly enlarging an adhesive bonding area of said packing (part of base 1a under lip portion 2 and lip portion 2) to said plate (4).

MIYAKE et al. discloses that his gasket prevents invasion of electronic equipment such as a top covering of a hard disk drive unit (see JPO's computer translation, section entitled "Field of the Invention", paragraph no. [0001]).

However, MIYAKE et al. fails to explicitly disclose that the packing extension portion is provided in an inflection portion or a position close thereto in a plane shape of said packing.

Any one of SHIKANO, ISHII et al., or NAKADA disclose electronic equipment in the form of a hard disk drive in which a plate is screwed to an opposing assembly member screw fixing portion at time of assembling. Thus, a gasket comprised of a packing and a packing extension portion would be provided in a position close to said screw fixing portion, an inflection portion, or a position close thereto in a plane shape of said packing because all of SHIKANO, ISHII et al., and NAKADA indicate that projecting portions are provided near the inflections and screw fixing portions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of MIYAKE et al. by providing it between the screwed together hard disk drive plates having inflection and screw fixing portions of any one of SHIKANO, ISHII et al., or NAKADA in order to have a gasket with a larger adhesion surface so as to better resist a bending moment to the gasket from being peeled away from the plate.

**As to claim 5** (and as best understood despite the 35 USC 112, second paragraph, indefiniteness discussed above), MIYAKE et al. in view of any one of SHIKANO, ISHII et al., or NAKADA discloses a gasket as claimed in claim 1 as discussed above, and MIYAKE et al. also discloses that the gasket (1) is used as a cover gasket for an electronic equipment (see JPO's computer translation, section entitled "Field of the Invention", paragraph no. [0001], wherein it states that the gasket prevents invasion of electronic equipment such as a top covering of a hard disk drive unit).

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over MIYAKE et al. (Japanese Patent Application Publication No. JP 2003-049949) in view of any one of SHIKANO (U.S. Patent No. 5,568,341), ISHII et al. (Japanese Patent Application Publication No. JP 09-282860), or NAKADA (Japanese Patent Application Publication No. JP 05-326731), as applied to claim 1 above, and further in view of SATOH et al. (U.S. Patent No. 6,623,684).**

**As to claim 4** (and as best understood despite the 35 USC 112, second paragraph, indefiniteness discussed above), MIYAKE et al. in view of any one of SHIKANO, ISHII et al., or NAKADA disclose a gasket as claimed in claim 1 as discussed above.

However, none of MIYAKE et al., SHIKANO, ISHII et al., or NAKADA disclose that the gasket is constituted by an integrally formed gasket in which the packing is integrally formed in the plate, and a pouring hole of a gasket forming material of a metal

mold at a time of integrally forming the gasket is arranged on the packing extension portion.

SATOH et al. (see Figs. 10-12 and reference numeral 76 representing a “burr”) disclose a gasket constituted by an integrally formed gasket in which the packing is integrally formed in the plate, and a pouring hole of a gasket forming material of a metal mold at a time of integrally forming the gasket is arranged on the packing extension portion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of MIYAKE et al. in view of any one of SHIKANO, ISHII et al., or NAKADA by forming the gasket in the manner as taught by SATOH et al. in order that any burrs formed avoid the contact portions.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various gasket configurations cited of interest are disclose in: U.S. Patent Application Publication No. 2005/0225039 to Seki et al.; U.S. Patent Application Publication No. 2002/0190484 and U.S. Patent No. 6,769,699 both to Seki et al.; U.S. Patent No. 6,619,667 to Kawaguchi et al.; U.S. Patent Application Publication Nos. 2005/0253342 and 2005/0253343 both to Hampton; and U.S. Patent Application Publication No. 2006/0074170 to Kojima et al.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)-272-6660. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*GAS*  
Gay Ann Spahn, Patent Examiner  
June 10, 2006

  
**PATRICIA L. ENGLE**  
**PRIMARY EXAMINER**